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**REMARKS****I. Introduction**

In response to the Office Action dated March 5, 2008, Applicants have amended independent claim 19 to more particularly point out and distinctly claim the subject matter of the invention. Claims 1-18 were previously cancelled without prejudice. Claims 23-25 were previously withdrawn. Care has been taken to avoid the introduction of new matter. In view of the foregoing amendments and the following remarks, Applicants respectfully submit that all pending claims are in condition for allowance. Claim 19 is independent.

**II. Claim Rejections Under 35 U.S.C. §§ 102 and 103**

Claims 19, 21, and 26 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hofschien (WO 99/00962) in view of Saida Kazuo (Japanese Publication No. 06-334729, machine English translation). Applicants respectfully traverse.

Claims 20 and 22 were apparently rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hofschien in view of Saida Kazuo in view of Chin. Applicants respectfully traverse.

In the interests of compact prosecution, Applicants will attempt to respond to these unclear rejections.

Amended independent claim 19 recites, in part:

volume control portion for controlling the volume of said replayed music and the volume of said talking voice of the telephone communication; and  
said volume control portion includes a talking volume adjusting part, a music volume adjusting part and a single control part controlling, mutually independently, said talking volume adjusting part and said music volume adjusting part.

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In order to establish *prima facie* obviousness under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. Further, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006). At a minimum, the cited prior art references do not disclose (expressly or inherently) or suggest the above recited highlighted (bolded) element.

The Office Action, at pages 3 and 4, asserts that all of the elements of claim 19 are allegedly disclosed by the combination of Hofschien and Saida Kazuo.

However, Hofschien, at page 1, lines 205 merely states, "a mobile telephone with an HF transmitter and receiver part, with a modulator/demodulator at least for voice signals, an NF part, a control unit, an input field, and a power supply unit including a battery."

Thus, Hofschien does not teach or suggest, **"a talking volume adjusting part, a music volume adjusting part and a single control part controlling, mutually independently, said talking volume adjusting part and said music volume adjusting part,"** as recited by claim 1.

Further, Saida Kazuo, at [0018] of the machine English translation, merely states, "... is mainly constituted by the memory 12 for messages, the memory 22 for music, and the sound reproduction mixing parts 18. It may be made to have the switch S1 grade which switches the output and line-in of the sound recording microphone 32, or line-in and these sound recording microphones 32 if needed."

Thus, Saida Kazuo does not teach or suggest, **"a talking volume adjusting part, a music volume adjusting part and a single control part controlling, mutually independently,**

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said talking volume adjusting part and said music volume adjusting part,” as recited by claim 1.

Thus, at a minimum, the combination of Hofshcen and Saida Kazuo fails to teach or suggest the forgoing limitation, and therefore does not render claim 19 obvious.

Additionally, in the structure of Saida Kazuo the volume of a message for an answering machine preliminarily stored in a memory 12 for a message is controlled by controlling a message volume set part 14 in a message volume control part 16. Similarly, the volume of background music preliminarily stored in a memory 22 for music is controlled by controlling a music volume set part 24 in a music volume control part 26.

As an illustrative and non-limiting example of claim 19, in FIG. 2 of the present application each of a talking volume adjusting part 203 and a music volume adjusting part 205 is controlled by a gain control part 201, whereby each of the talking volume and the replayed music volume is controlled. In other words, while the “message volume control part 16” and the “music volume control part 26” of Saida appears to correspond to the “talking volume adjusting part 203” and the “music volume adjusting part 205” in the present invention, respectively. Also, the “message volume set part 14” and the “music volume set part 24” of Saida appear to correspond to the “gain control part 201” in the present invention. Thus, whereas each of the talking volume and the replayed music volume is controlled by the single gain control part 201 when replaying music during telephone communication in the present invention, both the “message volume set part 14” and the “music volume set part 24”, which correspond, to the gain control part 201 in the present invention, are required to control each of the volume of a message for an answering machine and the volume of background music when superposing the message for an answering machine and the background music on each other and replaying the message

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for an answering machine and the background music in the invention of Saida. Therefore, the invention according to claim 19 and the invention of Saida are clearly different in structure from each other.

In addition, the number of constituent features required for controlling the volumes in claim 19 is smaller than that in the invention of Saida, whereby the benefit of inhibiting circuit constitution from complication can be obtained according to claim 19.

Further, for the purpose of argument, even if the invention of Saida is combined with the invention of Hofschien et al., "the talking volume and the replayed music volume" of this combination cannot be mutually independently adjusted, as required by claim 19.

Thus, as independent claim 19 is allowable for the reasons set forth above, it is respectfully submitted that dependent claims 20-22 and 26 are allowable for at least the same reasons as their respective base claim.

### **III. Conclusion**

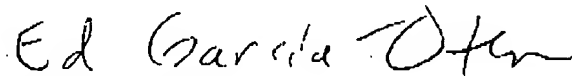
In view of the above amendments and remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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